C. Amendments to the Drawings

The attached marked-up drawings request deletion of FIGS. 1-6, re-numbering of FIGS. 7-19 to FIGS. 1-13, and amendment of various of the reference numerals to return the drawings generally to their original form as filed.

II. REMARKS

A. Introduction

In this Office Action claims 5-15 and 32-61 are noted as pending and are rejected. In this Response, the specification is amended, and remarks are provided.

B. Previous Section 112, Para. 1, Rejection

In the October 5, 2005 Office Action, page 3, the recitation "for propelling a toy vehicle" was rejected as lacking written description and enablement. In the January 5, 2006 Response, Applicant argued that the specification as filed did support the recitation. Alternatively, Applicant requested amendment of the specification to further describe the toy vehicle.

Based on a telephone conference with Examiner Comas on December 5, 2006, it is understood that the Examiner agrees with Applicant's comments in the January 5, 2006 Response that the added recitation "motor for propelling a toy vehicle" finds support in the application as filed. Accordingly, the October 27, 2006 Office Action includes no rejection under 35 U.S.C. § 112.

In light of this understanding, and the October 2, 2006 Decision on Petition, Applicant submits herewith a marked-up and clean version of a further substitute specification which removes the amendments to the specification requested in the January 5, 2006 Response. In effect, the substitute specification returns the specification generally to the form in which it was filed. However, the claims presented herewith continue to include the recitation "for propelling a toy vehicle" as same is supported in the specification.

C. Rejection of Claims Under 35 U.S.C. § 103

All pending claims are rejected as being made obvious by a combination of British Reference No. 2,046,602 of Jok, in combination with Japanese Reference No. 10/084650, of Sato. The Action alleges the Jok discloses the recited features, including "for propelling a toy vehicle", except for "a cylindrical case for covering and securing the motor unit or rotor, including the longitudinal axis, and a large case having a cylindrical conductive portion electrically connected between the second electrode terminal." For these features, the Examiner relies upon Sato.

For the following reasons, it is respectfully submitted that the present invention, as recited by claims 5-15 and 32-61, was not rendered obvious by the prior art.

As acknowledged by the Action, the present claims recite that the large case body is electrically connected between the second electrode terminal in the motor and an external battery. In contrast, in Jok, at most the second terminal/contact 5/33 is electrically connected between the motor case body 22 and the battery. See, e.g., Page 1, right column, lines 89-91 of Jok. Thus, at least this significant, fundamental difference exists in the respective structures of the present invention and Jok.

Further, Jok is much like the prior art discussed at page 1, numbered paragraph 3 of the present application, i.e., a motor with the two terminals/contacts 5/33 and 4/35 extending out the same end, i.e., "end bell 23", of the motor 3. See the attached, marked-up Fig. 2 of this reference. This structure differs from the present invention wherein only one contact (see reference numeral 41) extends out of the insulated small case body (40), and the large case body (20) per se serves as the conductive connector for the other electrode in the motor. This structure can help foster miniaturization that is not possible with a conventional motor requiring both electrodes to extend out of the insulative small case body, like in Jok. See again the present specification, page 1, numbered paragraph 4.

Thus, Jok teaches a structure different than that recited herein in several significant respects. Accordingly, the question under Graham v. John Deere is whether the prior art teaches modification of Kok to arrive at the present invention. It is respectfully submitted that the answer is no.

As for Sato, for the purposes of any necessary appeal, Applicant continues to rely on the comments included at least the August 25, 2005 Response that same is non-analogous art, i.e., same would not be considered by one of ordinary skill when attempting to improve upon propelled toys, because Sato is merely a vibratory motor for a pager or portable phone. The motor thereof is not and could not be operatively connected to propel a toy vehicle.

Nevertheless, the Action suggests that Sato's teaching would modify Jok to include a cylindrical case for covering, securing and providing a electrical connection to said motor. However, the issue is not merely providing a conductive cylindrical case, but modifying the structure of Jok to allow the case to serve as an electrode connection per se, i.e., the side of the motor serves to contact directly with a battery or through a conductive member. However, Jok already uses its case 22 as a conductor, albeit with a different structure than the present invention, as discussed above.

The Action does not advise what specific substitution would be obvious to change the electrode terminal structure of Jok to arrive at the present invention, based on the structure of Sato. If the electrode 5/33 of Jok were replaced by the electrode 5-1 of Sato, the connection to the battery shown in Fig. 1, i.e., the terminals 4 and 5 would be rendered incompatible at a minimum, or inoperative. See Page 1, left column, lines 51-58 and right column, lines 101-104: "The conductive leads 4 and 5 are made of resilient metal ... and form a unit with the motor 3, which unit is fitted into the chassis 1 by sliding so that a bushing 6 of the motor and a bushing 7 on the lead 5 are push-fitted into slots at either side of the chassis with the contact ends of the leads 4 and 5 entering the portion 2 through apertures 8 and 9. ... When pen dry cells are installed in the portion 2 of the chassis of the toy car, power is supplied to the motor via the leads 4 and 5 directly from the dry cells." This structure poses at least two issues.

First, connecting the battery to the ends of the leads most likely requires soldering which would frustrate manufacturing and miniaturization, as described at page 1, numbered paragraphs 3 and 4.

Secondly, and more importantly, if the internal electrode 5-1 of Sato (see Fig. 2 thereof) were to be incorporated in the Jok motor, the lead 5 could no longer be connected thereto (See Figs. 2-4 of Sato, which show the electrode 5-1 covered by the insulative case body 7), which totally frustrates a teaching of the Jok reference, a factor which counsels against obviousness. Then, how would the connection be made to the modified electrode of Jok replacing 33? Might it be the holder12/bracket 10 of Sato? However, such holder/bracket is only necessary to secure the motor when vibrating. Translation of record, paragraph [0014] on page 8. The Jok motor, like the present invention is entirely devoid of such vibratory requirements, and such a holder/bracket is unnecessary.

Overall, it is believed that Sato does not teach modifying the electrode 33 of Jok to include an electrode within the motor, and even if it did, it does not teach an effective and obvious way to connect this electrode, via the case, to "an external battery directly or through at least one conductive member."

D. Citation of Kaneko

Japanese Reference No. 2002-142400 of Kaneko et al. is cited in the PTO 892 attached to the Office Action. While the reference was apparently published on May 17, 2002, prior to the filing date of the above-referenced continuing application, the continuing application claims domestic priority from U.S. Application Serial No. 09/734,703, filed December 13, 2000. Accordingly, it is respectfully submitted that the effective U.S. filing date of the continuing application is December 13, 2000 (35 U.S.C. Section 120), and that this Kaneko reference is not prior art to the continuing application.

III. CONCLUSION

In light of the above amendments and remarks, it is respectfully submitted that claims 5-15 and 32-61 are now in condition for allowance.

If there are any additional fees associated with this Response, please charge same to our Deposit Account No. 19-3935.

Finally, if there are any formal matters remaining after this Response, the undersigned would appreciate a telephone conference with the Examiner to attend to these matters.

Respectfully submitted,

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Date: 1/29/07

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FIG.1

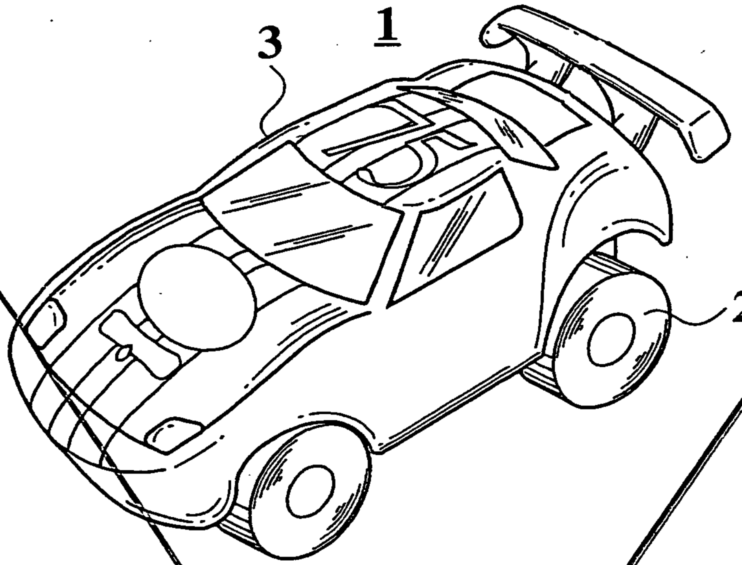

FIG.2

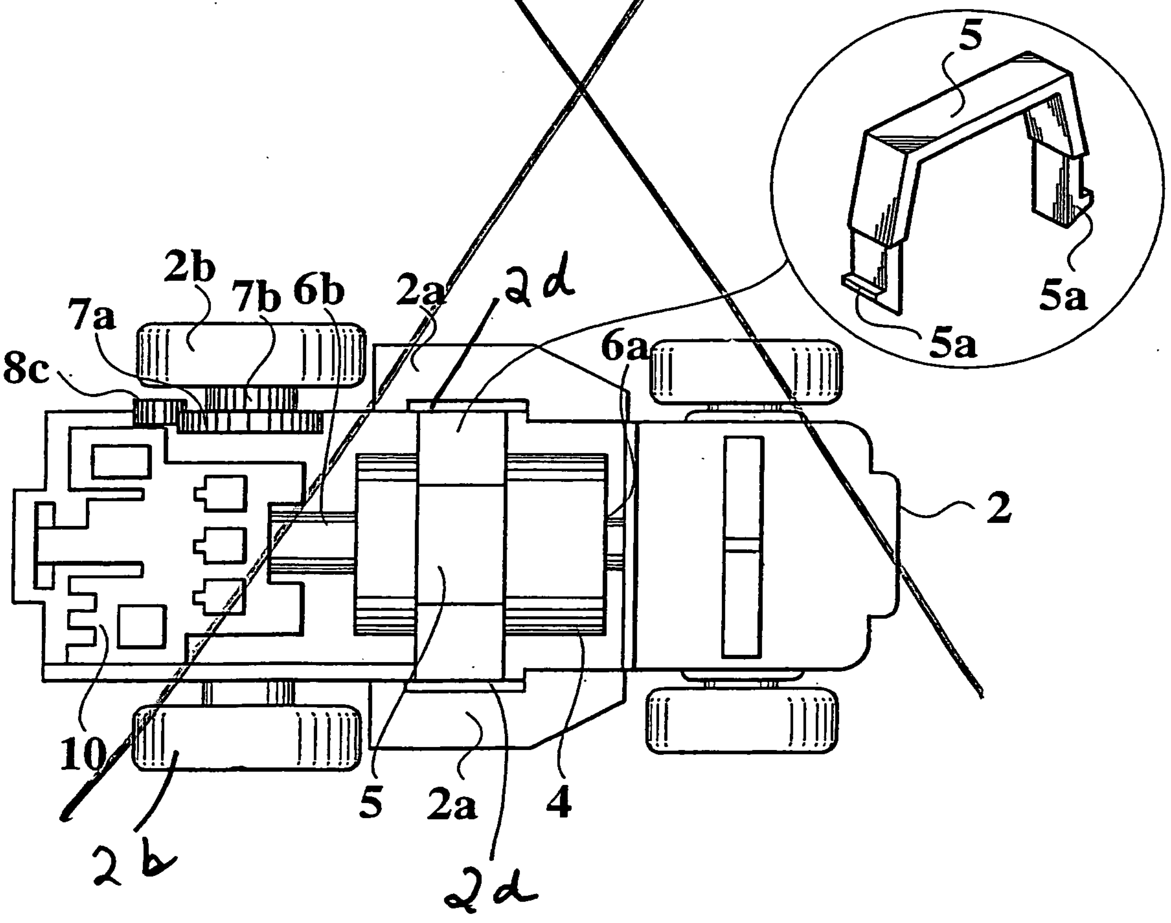

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FIG.3

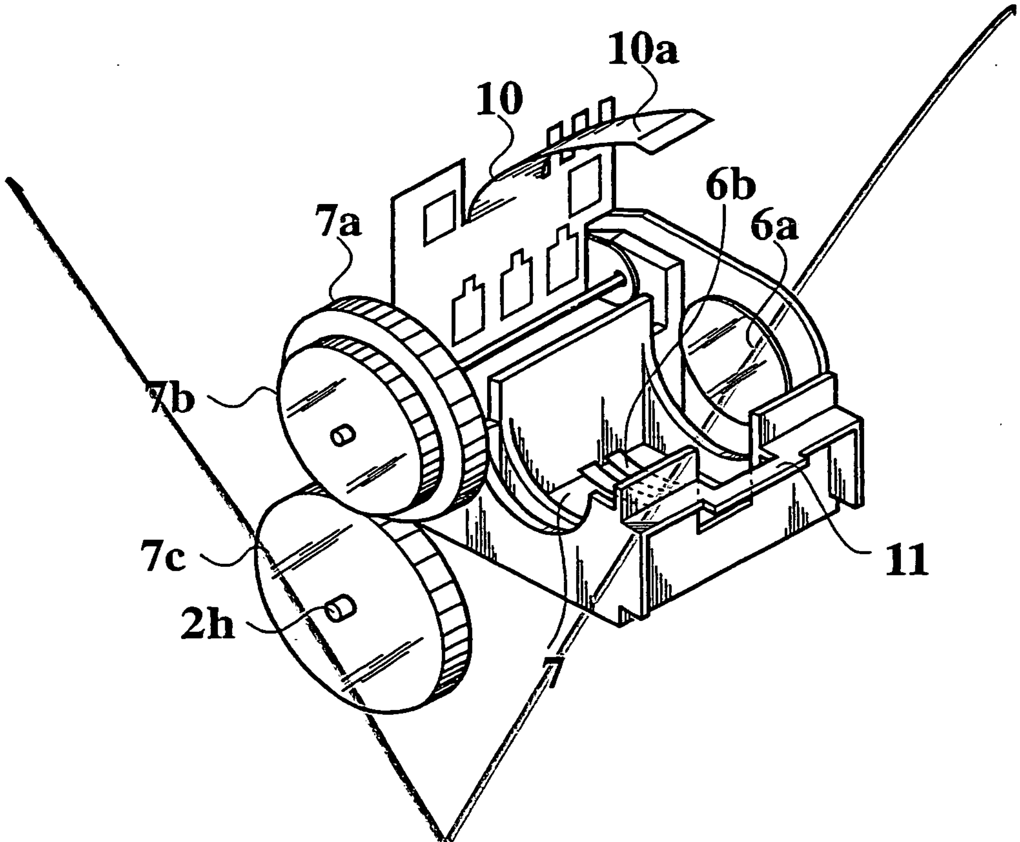

FIG.4

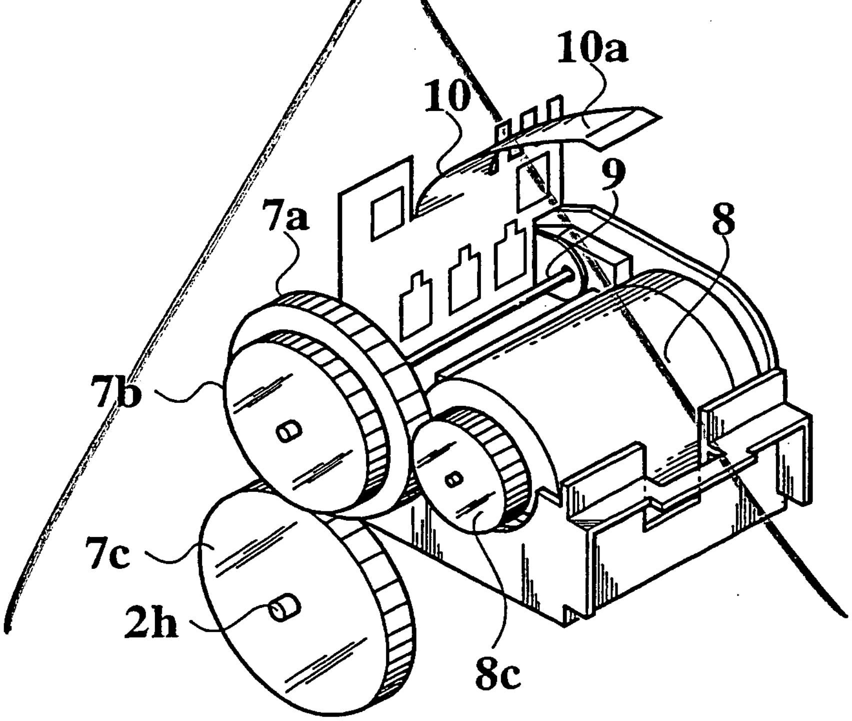

FIG.5

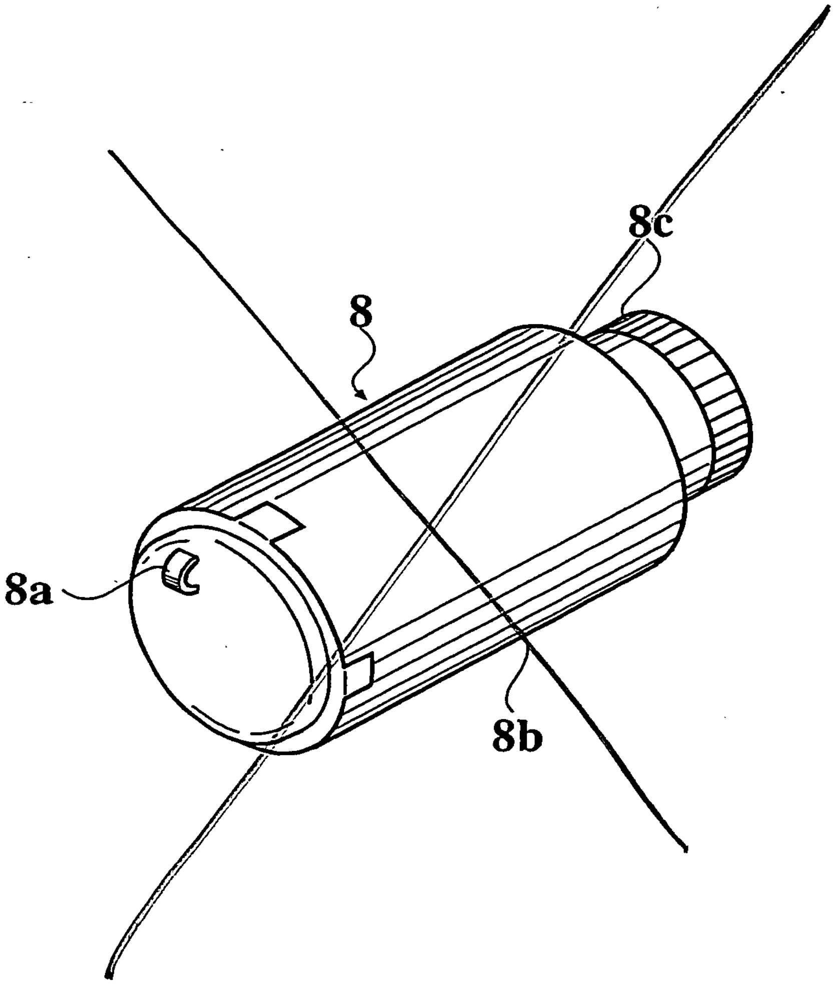

FIG.6

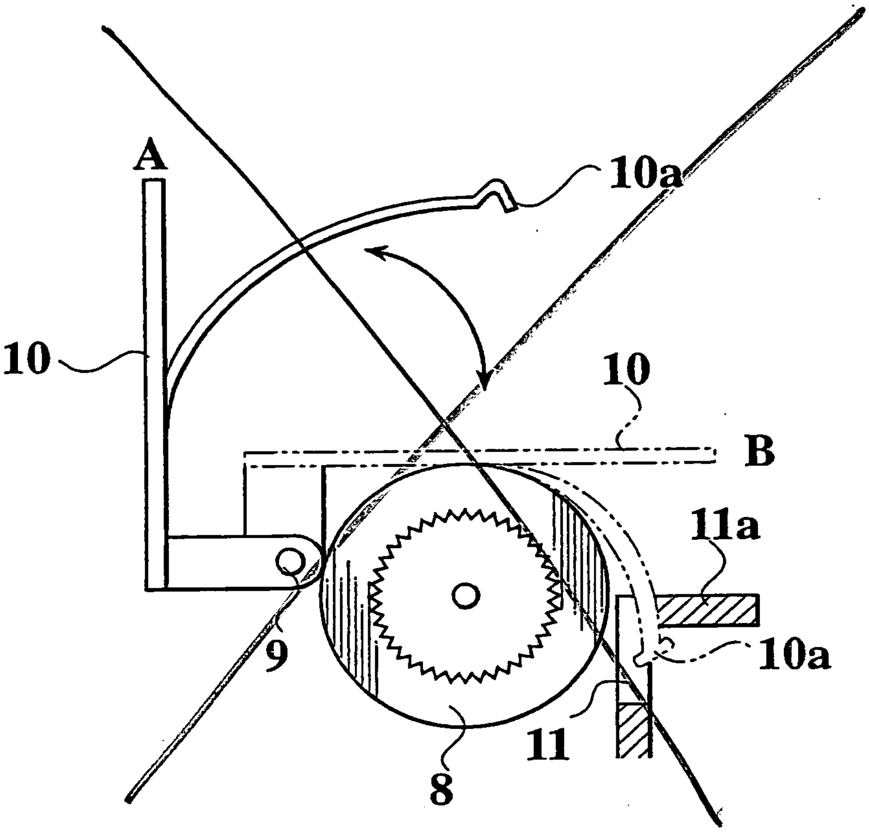

FIG. ~~7~~ 1

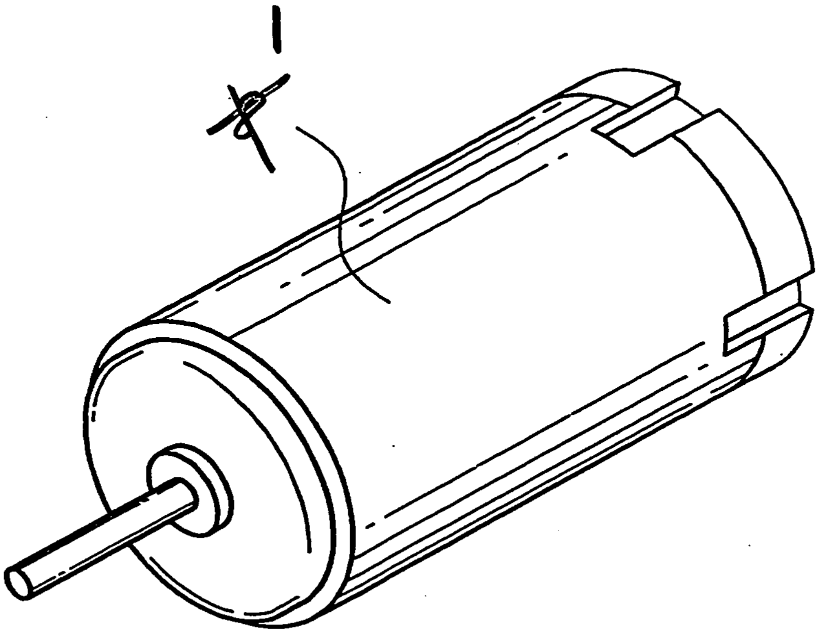

FIG. ~~8~~ 2

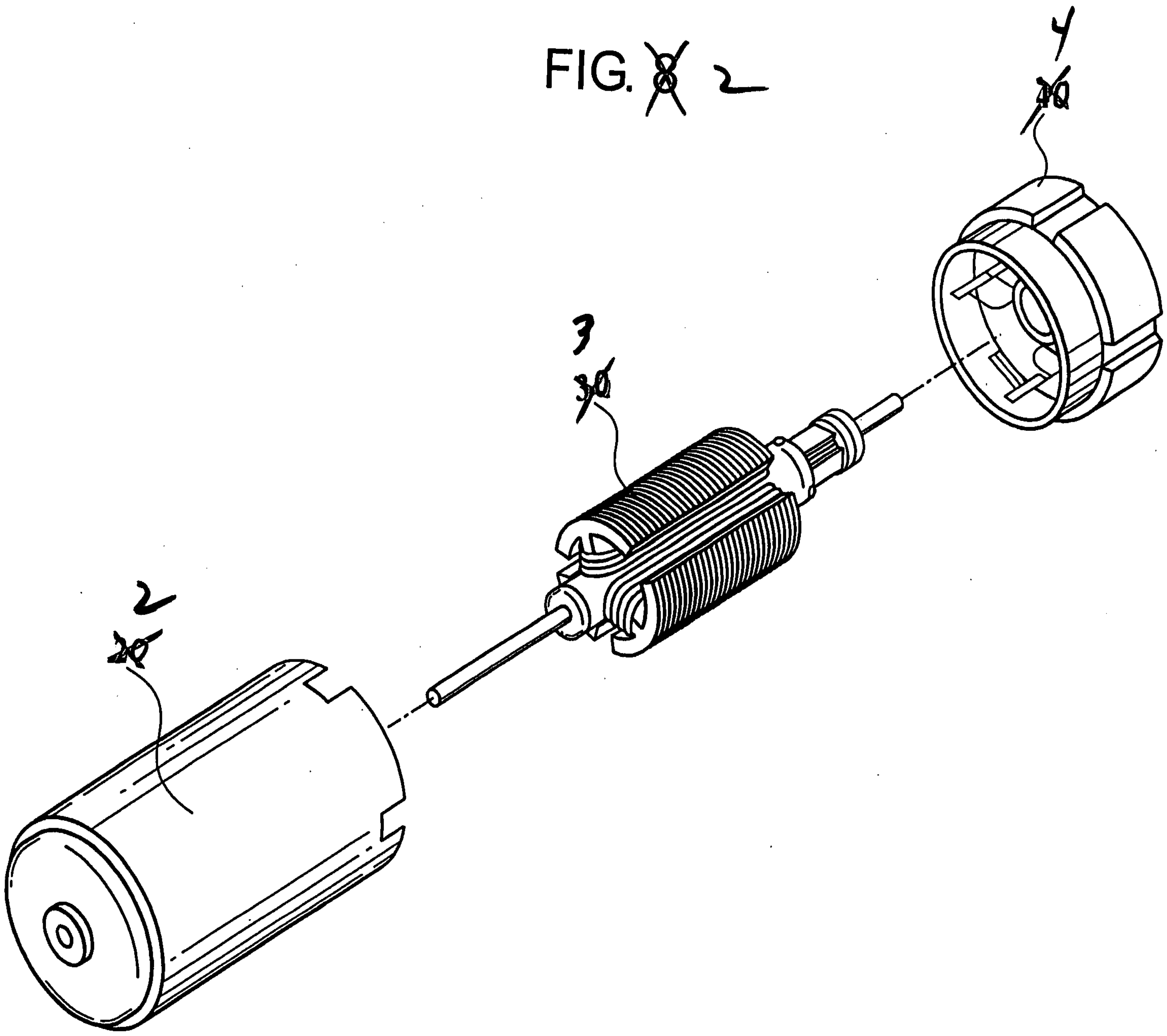

FIG. ~~9~~ 3

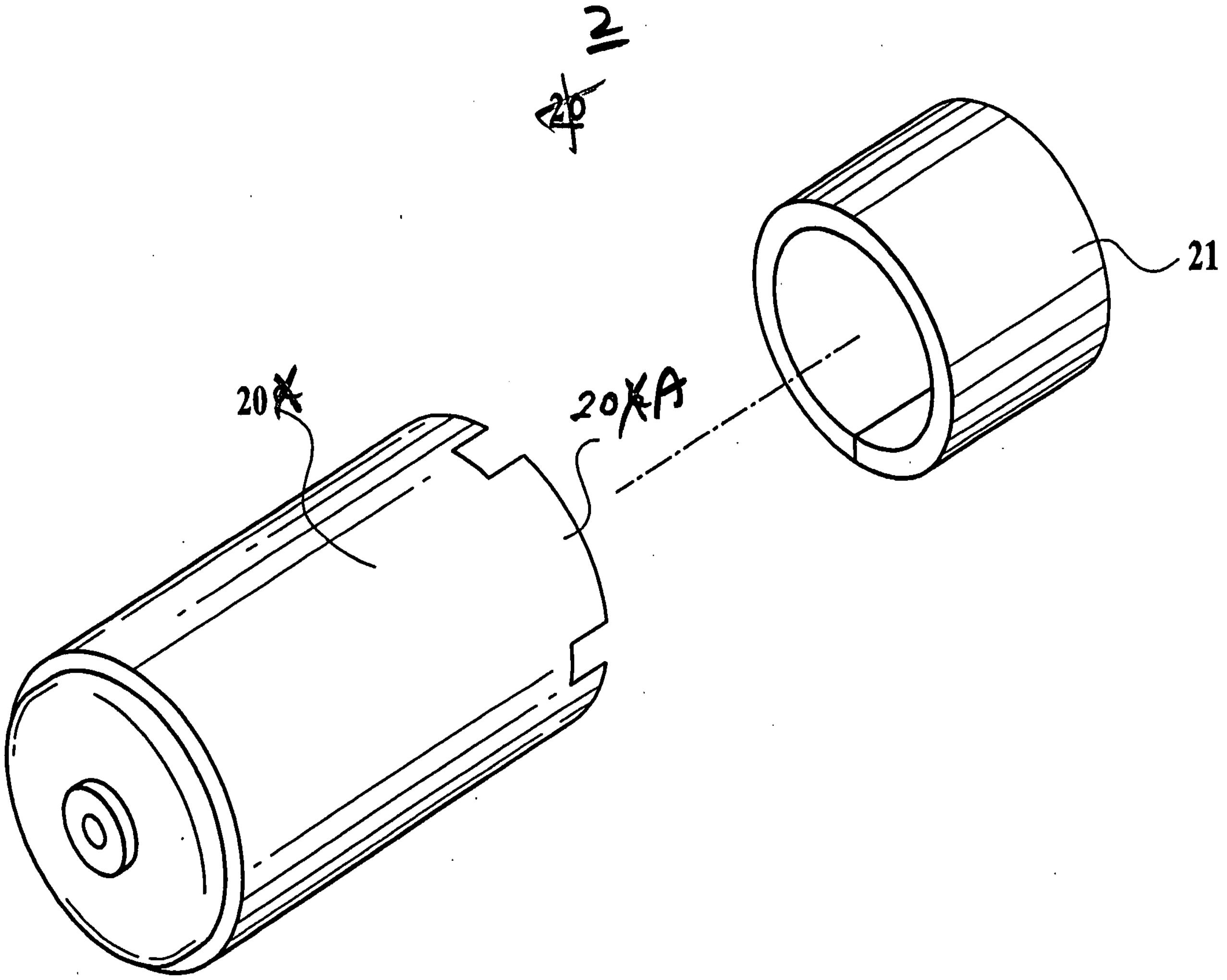

FIG. ~~10~~ 4

~~30~~ 3

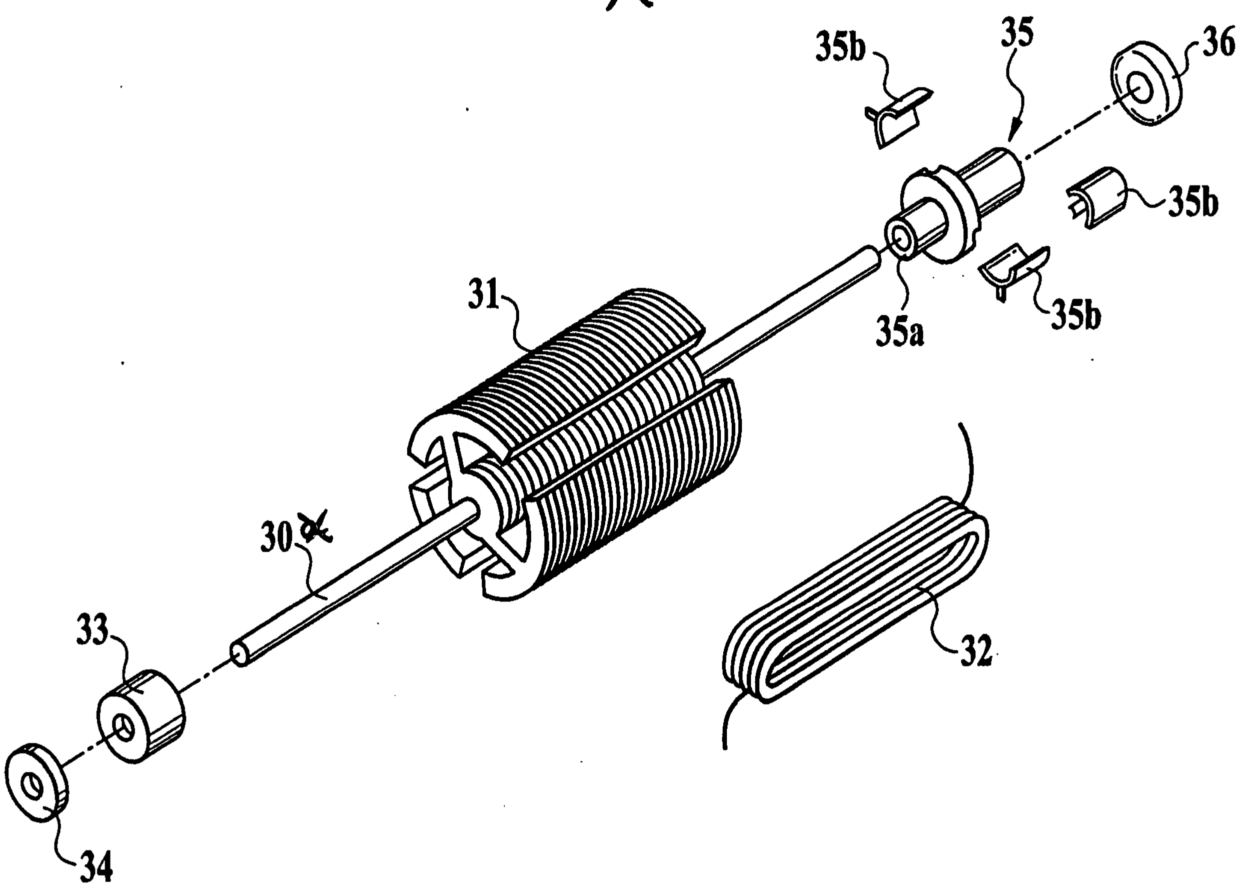

FIG. ~~11~~ 5

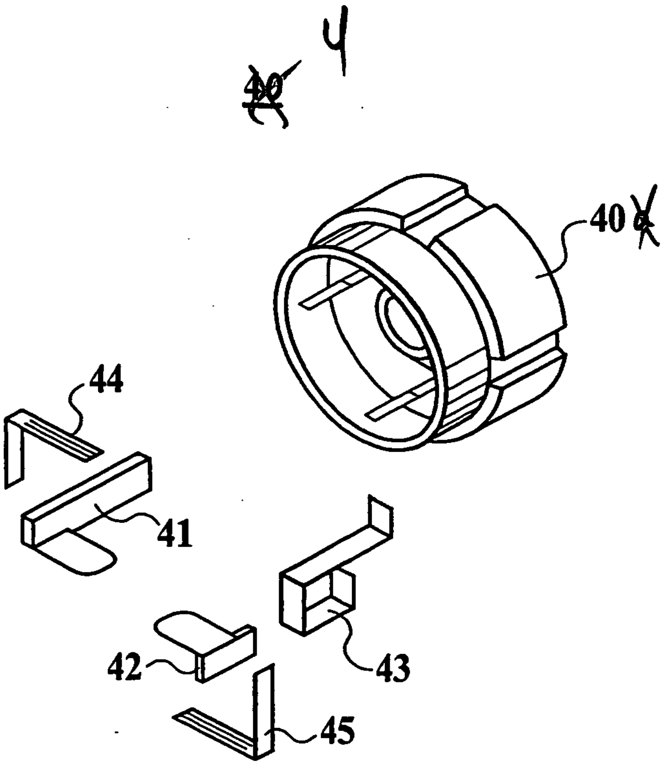

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FIG. ~~12~~ 6

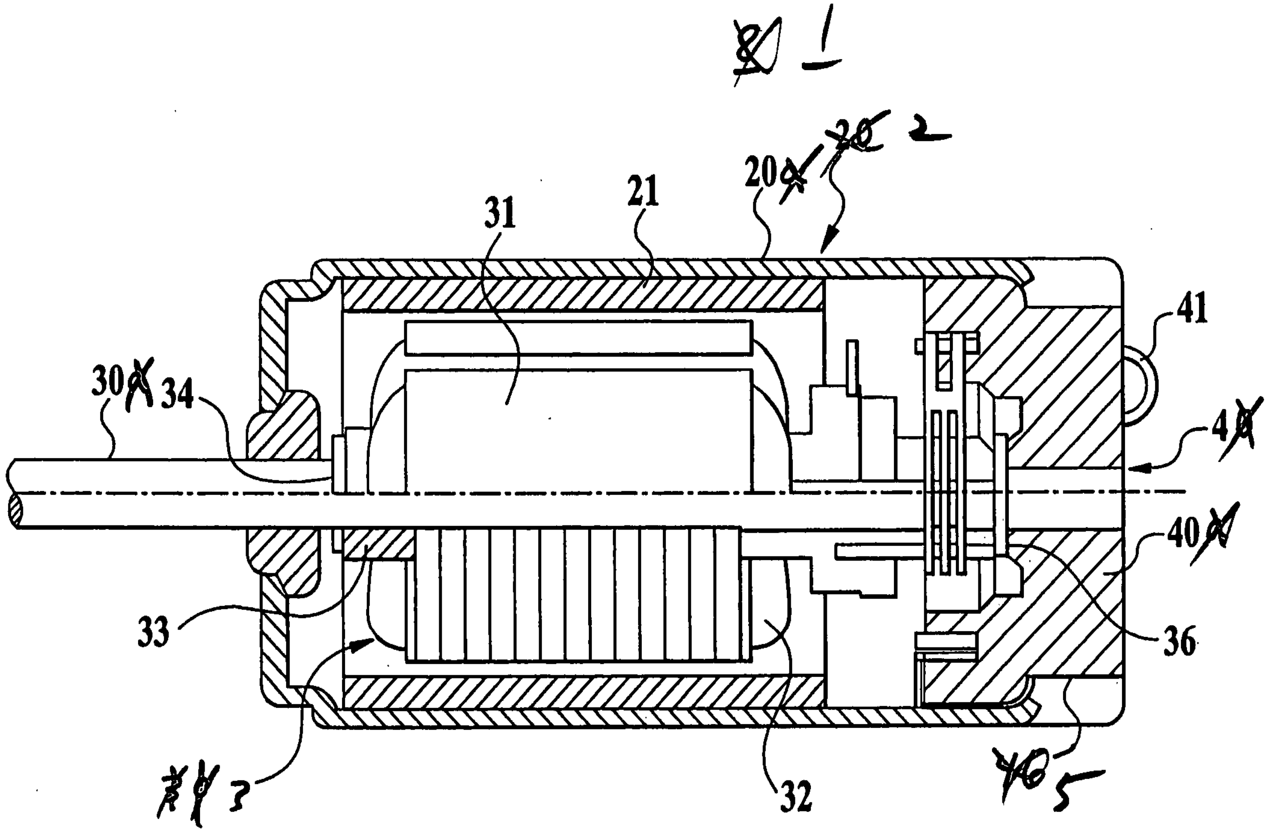

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FIG. 1~~8~~ 7

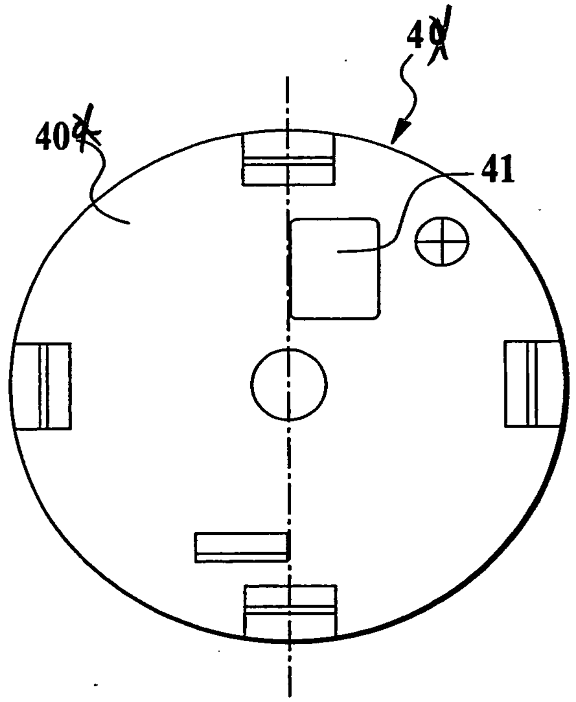

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FIG. ~~14~~ 8

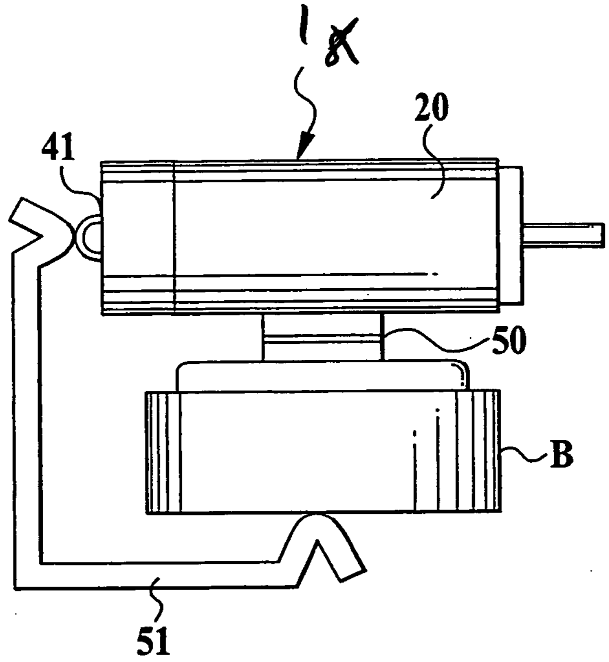

FIG. ~~15~~ 9

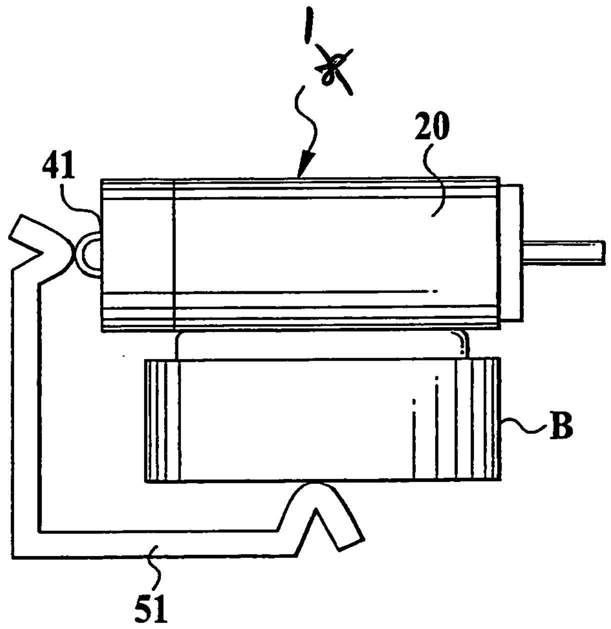

FIG. ~~16~~ 10

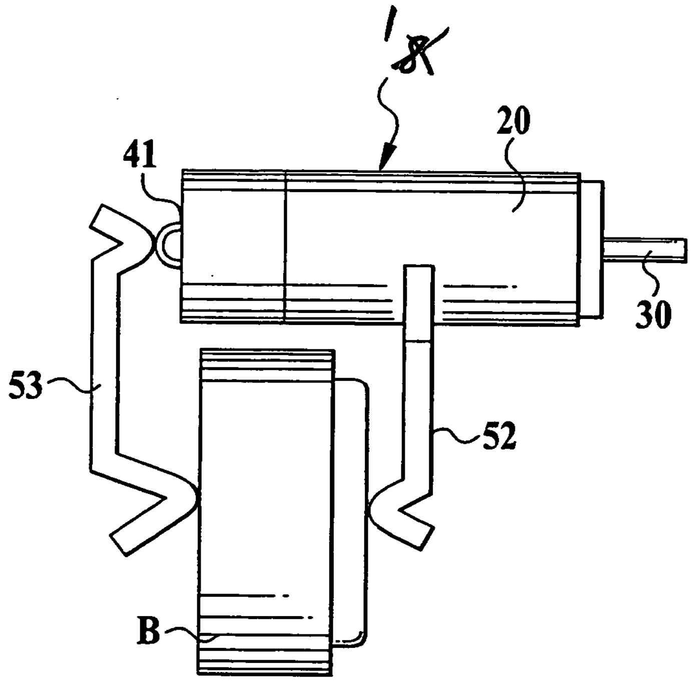

FIG. ~~17~~ 11

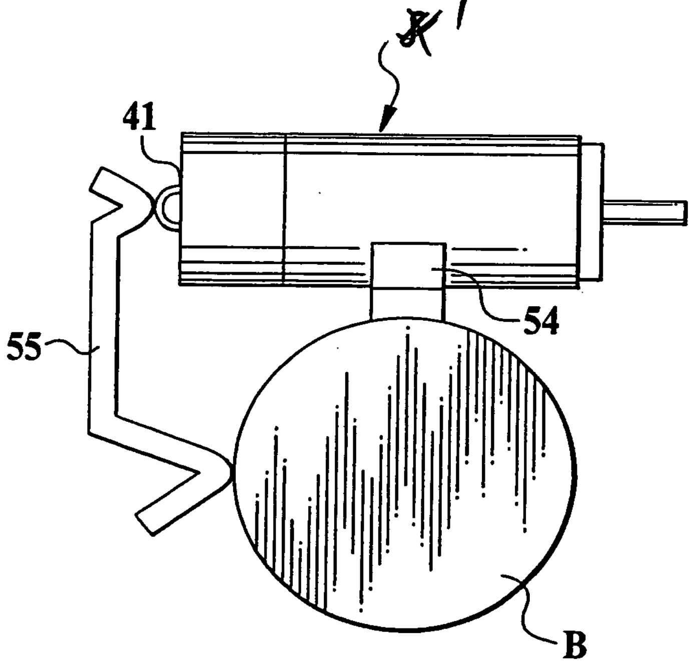

FIG. ~~18~~ 12

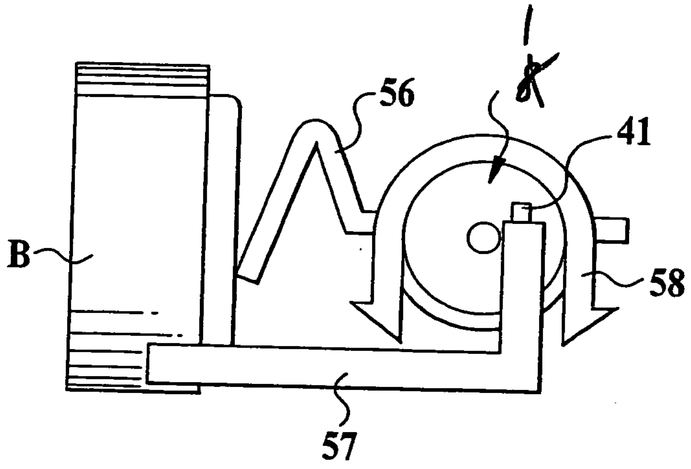

FIG. ~~19~~ 13